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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 676,475	09 29 2000	DANIEL RAJOTTE	P-LJ 4377	7437

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EXAMINER

MORAN, MARJORIE A

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 02 11 2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/676,475

Applicant(s)

RAJOTTE ET AL.

Examiner

Marjorie A. Moran

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 5-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 5-30 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Election/Restrictions***

Upon review of the claims and consideration of applicant's arguments set forth in the response of 10/21/02, the examiner realized that she omitted a restriction and erred in her delineation of species in the previous restriction/election requirement. The examiner regrets the error and the inconvenience to applicants. As the examiner realizes that this new restriction/election is an inconvenience to applicants, the time period for response to this Office Action is hereby extended to three months from the normal one month response time accorded to restriction requirements. The examiner agrees that SEQ ID NO: 17 is generic to SEQ ID NOS 1 and 2, as argued by applicant in the response, and has altered the species election to reflect the generic nature of SEQ ID NO: 17. Applicant is hereby required to elect one Group and a single species of sequence/structure for examination from those set forth below.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 5-15, drawn to a method of selectively directing a moiety to lung endothelium by administering a conjugate molecule comprising an MDP-binding molecule, classified in class 514, subclass 2.
- II. Claims 16-30, drawn to a method of reducing or preventing lung metastasis, classified in class 514, subclass 2.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are directed to different results and recite use different compounds. The

method of Group I recites administration of a conjugate comprising an MDP-binding molecule, whereas the method of Group II recites administration of an MDP-binding homing molecule. The MDP-binding molecule in the conjugate of Group I is not limited to be the same as the MDP-binding homing molecule of Group II, and a conjugate would be expected to have different properties than would an MDP-binding molecule alone. In addition, a search for a method of preventing/treating lung metastasis requires a search not required by a method of merely administering a compound to lung endothelium.

This application contains claims directed to the following patentably distinct species of the claimed invention: if applicant elects Group I, above, then applicant is further required to elect from the following species of MDP binding molecules:

- (a1) SEQ ID NO: 1, as set forth in claim 7, or
- (a2) SEQ ID NO: 2, as set forth in claim 7; wherein claim 6 is generic to claim 7, or
- (b) a structure as set forth in claims 8 and 20. If species (b) is elected, applicant is further required to elect a single species of structure from among those recited in claim 13.

If applicant elects Group II above, then applicant is further required to elect from the following species of MDP binding molecules:

- (a1) comprising SEQ ID NO: 1, as set forth in claims 18 and 19, or
- (a2) comprising SEQ ID NO: 2, as set forth in claims 18 and 19; wherein claim 17 is generic to claims 18 and 19; or
- (b) comprising a structure as set forth in claim 20. If species (b) is elected, applicant is further required to elect a single species of structure from among those recited in claim 25, or
- (c) an MDP-binding inhibitor, as set forth in claims 26-29.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 5 and 16 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marjorie A. Moran whose telephone number is (703) 305-2363. The examiner can normally be reached on Monday to Friday, 7:30 am to 4 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (703) 308-4028. The fax phone numbers for

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the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3524.

February 10, 2003

WILLIAM E. MOORE  
PATENT EXAMINER

*Wayne A. Moore*